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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/171,399	10/16/98	SANO M	KINOSHITACAS

IM22/0721
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EXAMINER	
EINSMANN, M	
ART UNIT	**PAPER NUMBER**
1751	10

DATE MAILED: 07/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/171,399	Applicant(s) Sano et al.
	Examiner Margaret Einsmann	Group Art Unit 1751

☐ Responsive to communication(s) filed on _____.

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *10-13 and 15-19* is/are pending in the application.

Of the above, claim(s) *10, 11, and 16-18* is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *12, 13, 15, and 19* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

This action is in response to the amendment received May 9, 2000. Claims 10-13, 15-19 are pending. Claims 10, 11, 16-18 are withdrawn from consideration as being drawn to a nonelected invention. Claims 12, 13, 15 and 19 are being examined in this action.

This application contains claims 10,11,16-18 drawn to an invention nonelected. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Applicant's amendment has mooted the rejection of claim 12 as anticipated under 35 USC by Harper Jr.

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 12 and 15 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 6, 7 of copending Application No. 09/189,958. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. Claims 12-13,15 are rejected under 35 U.S.C. 102(b) and (e)as being anticipated by Yamada et al., US 5,622,531. This rejection is maintained as applied in the office action of November 3, 1999 for the reasons of record.

Applicant's arguments filed 5/9/2000 have been fully considered but they are not persuasive. Applicant argues that the wool protein of Yamada has a molecular weight of several thousands to several hundred thousands in contrast with applicant's water-soluble organic substance which has a molecular weight of 100 to 20,000. Will applicant not agree that all of the wool proteins used in the process of Yamada having a MW of several thousand (say 6,000 or 7,000) to 20,000 reads on the instant claims? Applicant further argues that the protein of Yamada would have a harsh feel. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., feel or the garment coated by the product of the invention) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Additionally, the statement about the harsh feel is a conclusionary statement. Arguments or conclusionary statements unsupported by factual evidence are insufficient to establish unexpected results. See In re Linder, 173 USPQ 356 (CCPA 1972).

4. Claims 12,13,15 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kimura et. al., US 5,385,836.

A coating for non-woven fabric comprising silk fibroin, gelatin and insolubilized chitosan is disclosed. Noting comparative example 2 in column 7, a composition comprising an epoxy type crosslinking agent (which is certainly a reactive modifier), aqueous fibroin solution, and gelatin is disclosed. Gelatin is an albumin (protein) having a molecular weight of less than 2000. Though there is no molecular weight given for the aqueous solution of fibroin, it is an aqueous solution and thus is in a water soluble form, having been hydrolyzed to a polypeptide, thus reducing its molecular weight.

5. This rejection is maintained as applied in the action of 11/3/99. Applicant's arguments filed 5/9/2000 have been fully considered but they are not persuasive. Applicant states that there is no disclosure of forming a reaction product with a water-soluble organic substance a reactive modifier and then coating this on fibers. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., forming a reaction product and then coating this reaction product of the fibers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van*

Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Patentee forms a coating composition which comprises an epoxy crosslinking agent, aqueous fibroin solution and aqueous gelatin solution. Comparative example 2 does not disclose drying the polyurethane emulsion and epoxy crosslinking resin and then adding the water soluble proteins. On the contrary, the two proteins and the epoxy resin are all coated on the felt together. Thus when dried the reaction product, that is, the crosslinked product, is formed.

Applicant's amendments have necessitated the following new grounds of rejection.

6. Claims 12, 15 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Otoi et al., JP 4-100976 (English translation).

Application example 1 beginning on the bottom of page 15 anticipates these claims as disclosing a coating composition comprising silk fibroin of molecular weight 15,000 reacted with a cationic modifier, (3-chloro-2-hydroxypropyl)trimethylammonium chloride .

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is (703) 308-3826. The examiner can normally be reached on Monday to Thursday and alternate Fridays from 7:00 A.M. to 4:30 P.M. The fax phone number for this Technology Center is (703) 305-3599

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Margaret Einsmann

MARGARET EINSMANN

PRIMARY EXAMINER 1751

June 29, 2000